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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,131	11/13/2003	Andreas Schabert	104035.271436	8184

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EXAMINER

ELKINS, GARY E

ART UNIT PAPER NUMBER

3727

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,131

Applicant(s)

SCHABERT ET AL.

Examiner

Gary E. Elkins

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19 and 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20050211.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, figs. 1-3 and 9 in the reply filed on 16 December 2005 is acknowledged. The traversal is on the ground(s) that the search and examination of all the embodiments would not constitute serious burden as compared to the search and examination of the elected embodiment. This is not found persuasive because significant additional time would be required to search and examine all the embodiments as compared the elected embodiment. A search for and application of the prior art to the specific distinguishing details in all the embodiments would require significant additional time as compared to the elected embodiment.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 20 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Specification

3. The abstract of the disclosure is objected to because (1) it is not written single paragraph form, (2) the recitation regarding the drawings at the end does not constitute proper subject matter for an abstract and (3) the first paragraph of the abstract is written in single sentence claim format, i.e. it constitutes a run-on sentence. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: On page 6, line 14, reference is made to independent claims 1 and 2 as part of the specification and disclosure. It is noted that, at present, claims 1 and 2 are not present within the application and, due to possible renumbering if allowed or due to amendment, the specification could be indirectly changed. It is

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suggested that appropriate amendment be made to delete reference to the claims to avoid inadvertent amendment due to amendment to the claims and/or claim numbers.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 12-19 and 22-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, lines 8 and 9 and claim 22, lines 13 and 14, “an insertion tab...adapted for being fixedly attached to a perforated zone...” renders the claims unclear with respect to what is being claimed. The preamble indicates that a box is being claimed. However, the phrase “adapted for being fixedly attached” appears to be claiming a blank or an intermediate product as opposed to the completed box, i.e. if a box is being claimed, the insertion tab would already be attached. The phrase “adapted for being” involves a capability or future tense.

Claims 19 and 27 are unclear with respect to what is being claimed. The preambles indicate that a blank is being claimed. However, no blank limitations are being set forth. If the only limitations set forth are directed to the box, how is a blank being claimed?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any one of Giordano et al, Wagaman or Groeling.

8. Claims 12, 13, 15-17, 19, 22, 23, 25, 28, 27-29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Schultz (US '819) (fig. 6 emb). Schultz discloses a box and blank including side panels 11, 12, lateral side panels 13, 14, top closing flap 32, top dust flaps 33, 34, insertion tab 15 adapted to and capable of attaching to either perforated zone 40 or 50, cover flap 311 and hanger panels 312, 313 as claimed.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 18, 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (US '819) (fig. 6 emb). Schultz discloses all structure of the claimed box/blank except formation of the cover flap with a width of 55-60 percent of the width of the top closing flap. It would have been obvious as a mere arbitrary change in the size of the cover flap to form the cover flap with a width of 55-60 percent of the width of the top closing flap in Schultz. No functional distinction is seen nor is any functional distinction been asserted by Applicant with respect to the claimed dimension. Mere arbitrary changes in the size/shape of an element have been held to be obvious for one of ordinary skill in the art. See In re Dailey, 149 USPQ 47 (CCPA 1976), Graham v. John Deere Co., 148 USPQ 459 and Gardner v. TEC Systems, Inc., 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 225 USPQ 232 (1984).

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11. Claims 15-17, 19, 22, 23, 25-29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groeling in view of Schultz (US '819). Groeling discloses all structure of the claimed box/blank except provision of a double thickness hanger as claimed. Schultz teaches that it is known to make a double thickness hanger formed using end flaps of a box. It would have been obvious to make the box of Groeling with a double thickness hanger as taught by Schultz to permit hanging of the carton in Groeling at the end of the box while being capable of opening the box along the longitudinal seam.

12. Claims 15, 16, 19, 22, 25-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groeling in view of DE '053. Groeling discloses all structure of the claimed box/blank except provision of a double thickness hanger as claimed. DE '053 teaches that it is known to make a double thickness hanger formed using end flaps of a box. It would have been obvious to make the box of Groeling with a double thickness hanger as taught by DE '053 to permit hanging of the carton in Groeling at the end of the box while being capable of opening the box along the longitudinal seam.

Conclusion

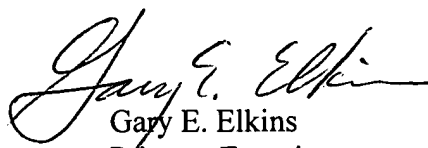
The remaining cited prior art is illustrative of the general state of the art.

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (571)273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. Also, copies of an office action or other file information may be obtained from the Private PAIR system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (571)272-4537. The Examiner can normally be reached Monday, Tuesday and Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Nathan Newhouse can be reached at (571)272-4544.


Gary E. Elkins
Primary Examiner
Art Unit 3727

gee
06 March 2006